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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,424

11/17/2003

Rajendran Nair

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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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In re Application of:
Rajendran Nair
Serial No.: 10/714,424
Filed: November 17, 2003
Title: METHOD & APPARATUS FOR CHARGING,
DISCHARGING AND PROTECTION OF
ELECTRONIC BATTERY CELLS

DECISION ON PETITION

This is a decision on the "Petition for fee waiver regarding 10/714,424 in response to OA mailed 07/21/08" filed on August 27, 2008, which petition is being treated as a petition to the Director under 37 CFR § 1.181(a)(1) requesting review of the action or requirement of the examiner in the *ex parte* prosecution of the instant application. No fee is required for the petition.

The petition is **GRANTED** to the extent that the actions and requirements of the examiner have been reviewed. Upon review, it has been determined that in the Office action mailed on July 21, 2008 the examiner erred in holding the amendment filed on March 17, 2008¹ non-compliant because no fee accompanied the amendment; rather, it has been determined that no fee was required for filing the amendment on March 10, 2008.

Petitioner's request for fee waiver is **DISMISSED** as moot, since no fee was required for filing the amendment.

BACKGROUND

An Office action was mailed December 16, 2005, which required restriction to one of three inventions under 35 U.S.C. 121. A response to the restriction requirement was filed on January 15, 2006. On April 21, 2006 a final Office action was mailed which made the restriction requirement final. On September 25, 2006 a response was filed in which applicant acknowledged the restriction requirement and elected one of the inventions. On November 29, 2006, a non-final Office action was mailed in which the examiner acknowledged applicant's

¹ The amendment was previously filed by facsimile transmission on March 10, 2008.

election in the reply filed on September 25, 2006 and treated the election as being an *election without traverse*.

Applicant filed a response to the non-final Office action on January 22, 2007, and the examiner issued a final rejection on October 10, 2007. A reply to the final rejection was filed on January 09, 2008. The examiner issued an Advisory Action on February 25, 2008, which indicated that applicant's reply had overcome all the rejections in the final rejection, but did not place the application in condition for allowance because the withdrawn claims needed to be canceled before the claims would be allowable. On March 10, 2008, applicant filed via facsimile transmission an amendment cancelling the withdrawn claims. A duplicate copy of the amendment was received in the mail on March 17, 2008. A Notice of Non-compliant Amendment was mailed on July 21, 2008 holding the amendment filed on March 17, 2008 non-compliant because no fee accompanied the amendment. The instant petition was filed on August 27, 2008 requesting waiver of the fee.

STATUTES, REGULATIONS AND PROCEDURES

35 U.S.C. 132 states:

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application;

35 U.S.C. 133 states:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.104 states:

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

37 CFR 1.134 states:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

MPEP § 821.02 states:

Under these circumstances [claims stand withdrawn without traverse], when the application is otherwise ready for allowance, the claims to the nonelected invention, except for claims directed to nonelected species and nonelected inventions eligible for rejoinder, may be canceled by an examiner's amendment, and the application passed to issue.

OPINION

A review of the application file record indicates that in the Advisory Action of February 25, 2008 the examiner indicated that the reply that applicant filed on January 9, 2008 overcame all of the rejections made by the examiner in the final rejection mailed on October 10, 2008. A review further indicates that no objection or requirement to cancel the nonelected claims was made by the examiner in the final rejection mailed on October 10, 2008. Accordingly, the Advisory Action of February 25, 2008 imposed a novel requirement on the applicant but did not provide the applicant with a minimal time period, not less than thirty days, in which to reply, as required by both the Statutes and Regulations. Insofar as reply filed on January 9, 2008 overcame all of the rejections in the final rejection of October 10, 2008 and there was no objection or requirement made, the reply constituted a complete response to the final Office action. As such, it tolled the period for filing a complete response to the final Office action. Consequently, the mailing of the Advisory Action on February 25, 2008 imposing a novel requirement without providing applicant with a time period, not less than thirty days, to reply was in error and is hereby **VACATED**. The examiner, following the guidance of the MPEP, was authorized to cancel the withdrawn claims by examiner's amendment and pass the application to issue. That the examiner did not to follow the guidance of the MPEP, nor comply with the Statutes and Regulations, should not be held against the applicant.

In view of the Advisory Action of February 25, 2008 being vacated, the Notice of Non-compliant Amendment mailed on July 21, 2008 is likewise **VACATED**.

In view of the failure of the Advisory Action of February 25, 2008 to properly set a time period for reply to the novel requirement to cancel the withdrawn claims, the reply filed by applicant on March 10, 2008 can only be construed as timely filed. Accordingly, it is concluded no fee was necessary for filing the amendment on March 10, 2008.

CONCLUSION

The petition is **GRANTED** to the extent that the actions and requirements of the examiner have been reviewed.

Upon review, it has been determined that the mailing of the Advisory Action on February 25, 2008 imposing a novel requirement without providing applicant with a time period, not less than thirty days, to reply was in error and is hereby **VACATED**. It has further been determined that the examiner erred in holding the amendment filed on March 17, 2008 non-compliant because no fee accompanied the amendment; rather, it has been determined that no fee was required for filing the amendment filed first on March 10, 2008 and later on March 17, 2008.

Petitioner's request for fee waiver is **DISMISSED** as moot, since no fee was required for filing the amendment.

The application file is being returned to the examiner for further action not inconsistent with this decision. In view of the fact that the reply filed on January 9, 2008 overcame all the rejections in the final Office action of October 10, 2007, and insofar as the reply filed on March 10, 2008 cancels the withdrawn claims, the amendment filed on March 10, 2008 **will be entered** and appropriate action taken by the examiner.

Inquiries regarding this decision should be directed to Clayton E. LaBalle, Special Programs Examiner, at (571) 272-1594.

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